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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,991	07/08/2003	Yoshikazu Watanabe	1046.1295	6252

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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/613,991

Applicant(s)

WATANABE ET AL.

Examiner

Walter F Briney III

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/08/03; 12/16/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. **Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.**

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-6 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sudo et al. (US Patent 6,223,058).**

Claim 1 is limited to *an information processing terminal*. Sudo discloses a communication terminal apparatus and control method thereof. See Abstract. The terminal apparatus is depicted in figures 2-4 as a cellular/mobile telephone. The telephone includes a rotary switch (4). The telephone includes many functions that are accessed by way of the rotary switch (4), these include a telephone book, alarm, volume control, and, of course, calling (i.e. *a rotary operation unit provided on a terminal stored with a variety of functions and performing a various operations of said terminal by*

*a rotational operation thereof*). See figures 18, 27, 31, and column 10, lines 24-31.

Sudo discloses that the rotary switch operates by detecting the direction of the rotary switch based on which track first generates an electrical pulse. The amount of rotation is tracked by a counter within the controller (i.e. *a rotational volume measuring unit measuring a rotational volume of said rotary operation unit*). See column 9, line 60 to column 10, line 6. Sudo depicts in several figures that the rotational motion of the switch is symbolized on the LCD of the communication terminal (i.e. *an output unit outputting an output based on an operation result of said rotary operation unit*), the controller being ultimately responsible for indicating these results to the LCD (i.e. *an operation content notifying unit notifying of a content of the operation result causing said output in accordance with a result of measurement by said rotational volume measuring unit*). Therefore, Sudo anticipates all limitations of the claim.

Claim 2 is limited to *an information processing terminal according to claim 1*, as covered by Sudo. As indicated in the rejection of claim 1, Sudo discloses an alarm feature (column 15, lines 32-36). Alarms are devices that are programmed to generate a notification at a certain time (i.e. *further comprising a timer unit setting said operation content notifying unit to notify at a predetermined time*). Therefore, Sudo anticipates all limitations of the claim.

Claim 3 is limited to *an information processing terminal according to claim 1 or 2*, as covered by Sudo. The display for making a call, depicted in figure 21, includes the most frequently called contacts, arranged from 1-to-9. Thus, the contact (Robert) is the maximum and the contact (Nick) is the minimum. Sudo discloses that these values are

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navigated using the rotary switch, thus when the cursor (K) highlights (Robert), the output is at a max, and when the cursor (K) highlights (Nick), the output is at a min (i.e. *wherein said operation content notifying unit notifies that an output content outputted from said output unit is a maximum or minimum*). See column 11, lines 12-20.

Therefore, Sudo anticipates all limitations of the claim.

Claim 4 is limited to *an information processing terminal according to any one of claims 1 through 3*, as covered by Sudo. Figures 2-4 depict the motion of the rotary switch (4). The UP direction is analogous to clockwise and the DOWN direction is analogous to counterclockwise. As indicated in column 11, lines 12-20, moving the rotary dial upward causes the display to approach the maximum entry (Robert) (i.e. *wherein an output level from said output unit changes to a direction of maximum output value as said rotary operation unit rotates clockwise*). Therefore, Sudo anticipates all limitations of the claim.

Claim 5 is limited to *an information processing terminal according to any one of claims 1 through 4*, as covered by Sudo. Figures 2-4 depict the motion of the rotary switch (4). The UP direction is analogous to clockwise and the DOWN direction is analogous to counterclockwise. As indicated in column 11, lines 12-20, moving the rotary dial downward causes the display to approach the minimum entry (Nick) (i.e. *wherein the output level from said output unit changes to a direction of minimum output value as said rotary operation unit rotates counterclockwise*). Therefore, Sudo anticipates all limitations of the claim.

Claim 6 is limited to *an information processing terminal according to any one of claims 1 through 5*, as covered by Sudo. Sudo discloses the operation of the rotary switch in connection with figures 15 and 16. The controller counts the number of pulses, and thus, can detect the number of rotations that have occurred (*i.e. wherein said rotational volume measuring unit measures an angle of rotation or the number of rotations of said rotary operation unit*). See column 9, line 60 to column 10, line 6). Therefore, Sudo anticipates all limitations of the claim.

Claim 9 is limited to *an information processing terminal according to any one of claims 1 through 6*, as covered by Sudo. Figure 30 depicts more menus for use in the communication terminal of Sudo. In particular, the LCD Density can be adjusted; this corresponds to brightness setting (*i.e. wherein said rotary operation unit controls a luminance on a screen of a display device*). Therefore, Sudo anticipates all limitations of the claim.

Claim 10 is essentially the same as claim 9, and is rejected for the same reasons.

The method steps of claims 11 and 12 are inherently performed by the information processing terminal of claim 1. Therefore, claims 11 and 12 are rejected for the same reasons as claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudo in view of Inagaki (Japanese Patent Laid-Open Publication No. Hei 8-250945).**

Claim 7 is limited to *an information processing terminal according to any one of claims 1 through 6*, as covered by Sudo. Up to this point, the *output unit* has been taken to be an LCD display of the communication terminal disclosed by Sudo. Thus, Sudo anticipates all limitations of the claim with the exception *wherein said output unit is a loudspeaker for outputting a voice, and said operation content notifying unit notifies of the operation content by the voice*.

Inagaki teaches a sound volume setting circuit that enables a user of a mobile communication terminal, such as that disclosed by Sudo, to adjust the volume of a received signal during communication. While Sudo suggests this, the method of Inagaki provides the further advantage of generating a volume tone that distinguishes when a volume has reached a max or min value. This allows a user to have a better sense of how much change has been added, and how to return the volume to its original position after communication. See pages 2-3. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the operation tone as taught by Inagaki for the purpose of allowing a user to easily discern a sound volume setting and allowing them to return their volume to their preferred setting after communication.

Claim 8 is limited to *an information processing terminal according to claim 7*, as covered by Sudo in view of Inagaki. Sudo discloses adjusting the volume of the received signal during communication using the circumferential motion of the rotary switch (i.e. *wherein said rotary operation unit controls a level of the sound outputted from said loudspeaker*). Therefore, Sudo in view of Inagaki makes obvious all limitations of the claim.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F Briney III whose telephone number is 703-305-0347. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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WFB

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PRIMARY EXAMINER